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EXAMINER

VU, H

ART UNIT

PAPER NUMBER

2811

DATE MAILED:

12/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/328,645

Applicant(s)  
CHUNG

Examiner  
HUNG K. VU

Group Art Unit  
2811



☒ Responsive to communication(s) filed on Oct 27, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) 9-16 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-8 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Invention of Group I, Claims 1-8, in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the Examiner is alleging that the inventions of groups one and two are distinct, although absolutely no showing of such distinctness has been made, and the requirement to restrict the present application would be an unnecessary burden upon the Applicants and the Examiner's failure to follow the mandates of the statute and regulation would be denial of due process. This is not found persuasive because even though 35 U.S.C. 121 authorizes restriction of two or more independent and distinct invention, the term "and" has long been understood as "or". The law has long been established that dependent inventions (frequently termed related inventions) may be properly divided if they are, in fact "distinct" inventions, even though dependent. The term "distinct" means that two or more subjects as disclosed are related, for example as combination and subcombination, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art.) It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects. See MPEP 802.01. Furthermore every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct, and (2) the reasons for insisting upon

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restriction therebetween. See MPEP 808. Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05 (c-l), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (1) separate classification thereof, (2) a separate status in the art when they are classifiable together, or (3) a different field of search. See MPEP 808.02.

The restriction requirement for Group II (claims 9-16) and Group I (claims 1-8) which are related as process of making and product made, sets forth a two way distinction between the inventions of Group II and Group I. In another words, the process of Group II could be used to fabricate other and materially different product such as light receiving device. On the other hand, the product of Group I could be made by another and materially different process such as selective deposition means instead of depositing and removing. Thus the inventions of Group I and Group II are distinct inventions. See MPEP 806.05 (f). In addition, said Group I is classified in class 257 and said Group II is classified in class 438, as set forth in the Restriction Requirement. Thus the inventions of Group I and Group II acquire a separate classification thereof. Therefore, the requirement for restriction between patentably distinct inventions of Group I and Group II is proper. See MPEP 808 and 808.02.

The requirement is still deemed proper and is therefore made FINAL.

2: Claims 9-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected Invention, the requirement having been traversed in Paper No. 6.

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3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Embodiment 1 of Figures 2C, 3A-3G.

Embodiment 2 of Figures 2D, 4A-4H.

Embodiment 3 of Figures 2E, 5A-5F.

Embodiment 4 of Figures 2F, 6A-6G.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### *Conclusion*

4. Papers related to this application may be submitted to Technology Center (TC) 2800 by facsimile transmission. Papers should be faxed to TC 2800 via the TC 2800 Fax center located in Crystal Plaza 4, room 4-C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 2811 Fax Center number is (703) 308-7722 and 308-7724. The Group 2811 Fax Center is to be used only for papers related to Group 2811 applications.

Any inquiry concerning this communication or any earlier communication from the Examiner should be directed to **Hung K. Vu** whose telephone number is (703) 308-4079. The Examiner is in the Office generally between the hours of 7:00 AM to 4:00 PM (Eastern Standard Time) Monday through Friday.

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Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center Receptionists** whose telephone number is **308-0956**.

Tom Thomas

Tom Thomas  
Supervisory Patent Examiner  
Technology Center 2800

Vu

December 11, 1999